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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/825,207	04/02/2001	William K. Meade II	10002844-I	2700

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
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EXAMINER

PHAM, THIERRY L

ART UNIT PAPER NUMBER

2624

DATE MAILED: 12/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/825,207	Applicant(s) MEADE ET AL.	
	Examiner Thierry L. Pham	Art Unit 2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2005.
 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8-14, 16-35 and 37-42 is/are pending in the application.
 4a) Of the above claim(s) 19-35 and 37 is/are withdrawn from consideration.
 5) ☐ Claim(s) _____ is/are allowed.
 6) ☒ Claim(s) 1-6, 8-14, 16-18 and 38-42 is/are rejected.
 7) ☐ Claim(s) _____ is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

- This action is responsive to the following communication: RCE filed on 8/4/05 and Reply to Restriction requirement filed on 11/17/05 (respectively).
- Claims 1-6, 8-14, 16-35, and 37-42 are pending; Claims 7, 15, and 36 have been canceled.

Election/Restrictions

Applicant's election without traverse of Group I in the reply filed on 11/17/05 is acknowledged. Claims 19-35, and 37 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected inventions, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 11/27/05.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not provide an adequate written description of the limitations as recited in claim 1, wherein "wherein the facilitating comprises *downloading the software update from the component memory*"; therefore, it does not enable one skilled in the art to make, use and/or practice the invention. The examiner cannot locate any teachings that correspond to the above-cited limitations/features. Component memory of ink cartridge only contains *software update information* and does not contain any *actual software update, according to the originally filed specification*. Rather, software update is downloaded from a vendor's website to a printer's memory component. In addition, if the software update is already stored on a component

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memory, then it is not necessary to download a software update from a component memory to a component memory as cited in claim 1. Herein, the examiner interprets downloading software update from the vendor's website. (See page 9, lines 1-9, page 13, lines 4-25, and page 18 of originally filed specification for details).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2, 6, 8-14, 16, 18, 38-42 are rejected under 35 U.S.C. 102(a) as being anticipated by Benjamin et al (US 6113208).

Regarding claim 1, Benjamin discloses a method, comprising:

- retrieving software update information (retrieving printer driver software update information from memory 20, fig. 4, cols. 3-4) from component memory (memory device 20, fig. 3) of a printing device replaceable component (ink cartridge contains memory device 20, fig. 3);
- validating authority (notifying users of updated/newer version of printer driver, fig. 4, wherein user provides authority for downloading) to download a software update identified by the software update information (downloading updated/newer version of printer driver, col. 4, col. 1-20); and
- upon validation, facilitating a download (downloading updated/newer version of printer driver, fig. 4, cols. 3-4) of the software update utilizing the software update information from the component memory, wherein the facilitating comprises downloading the software update from the component memory (downloading from vendor's website, fig. 4).

Regarding claim 2, Benjamin further discloses the method as recited in claim 1, wherein the validating further comprises producing a user prompt requesting authorization (requesting users to download new version of printer driver, fig. 4, cols. 3-4) to download the software update and validating that authority has been granted to download the software update if the user responds in the affirmative to the user prompt (inherently, authority validation is required before downloading any updates to printer).

Regarding claim 6, Benjamin further discloses the method as recited in claim 1, wherein the authority to download the software update is provided at the time the printing device (printer, fig. 4, cols. 3-4) is installed.

Regarding claim 8, Benjamin further discloses the method as recited in claim 1, wherein the facilitating further comprises accessing a pointer in the software update information and accessing a site referenced (manufacture's website, cols. 3-4) by the pointer to locate and download the software update.

Regarding claim 9, Benjamin further discloses the method as recited in claim 1, wherein the facilitating further comprises accessing a telephone number (telephone number, fig. 4, cols. 3-4) of a remote access site in the software information and utilizing the telephone number to locate and download the software update.

Regarding claim 10, Benjamin further discloses the method as recited in claim 1, wherein the facilitating further comprises accessing a telephone number of a vendor site in the software information and facilitating display of the telephone number to a printing device user (telephone number, fig. 4, cols. 3-4), wherein the user can call the telephone number to order the software update.

Regarding claim 11, Benjamin further discloses the method as recited in claim 1, wherein the facilitating further comprises accessing a universal resource locator (URL) in the software information and facilitating display of the URL to a printing device user, wherein the user can

manually access the URL to order the software update (manufacture's website URL, fig. 4, cols. 3-4).

Regarding claim 12, Benjamin further discloses the method as recited in claim 1, wherein the facilitating further comprises accessing a printable form (order form, col. 4, lines 20-40) using the software information and causing the form to be printed on the printing device, wherein the user can complete the form and send it to a vendor to order the software update.

Regarding claim 13, Benjamin discloses a printing device, comprising:

- a replacement component (ink cartridge, fig. 3);
- component memory (ink cartridge contains memory device 20, fig. 3) integrated into the replaceable component; and
- software update information stored in the component memory (printer driver software update information from memory 20, fig. 4, cols. 3-4), the software update information including information to determine if there is an update available for the printing device (for printer device as shown in fig. 1) and for initiating a software update upon authorization from the printing device user (requesting users to download new version of printer driver, fig. 4, cols. 3-4), the software update information further including the update available (information regarding updated/newer version of printer driver, fig. 4, cols. 3-4) for the printing device.

Regarding claim 14, Benjamin further discloses the printing device as recited in claim 13, wherein the software update information for initiating a software update further comprises means to display a message to the user that indicates how the user can obtain the software update (displays websites and phone numbers, fig. 4, cols. 3-4).

Regarding claim 16, Benjamin further discloses a printing device (printer 1, fig. 1), comprising:

- a replacement component (ink cartridge, fig. 2);
- component memory (ink cartridge contains memory device 20, fig. 3) integrated into the replaceable component; and

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- software update information (printer driver software update information from memory 20, fig. 4, cols. 3-4) stored in the component memory, the software update information including information to determine if there is an update available for the printing device (fig. 4) and for initiating a software update upon authorization ((requesting users to download new version of printer driver, fig. 4, cols. 3-4, and inherently, authority validation is required before downloading any updates to printer) from the printing device user, wherein the software update information for initiating a software update further comprises a pointer (URL, fig. 4) that may be provided to an embedded web server in the printing device so that the printing device can access the pointer and download the software update from the site (vendor's website, fig. 4).

Regarding claim 18, Benjamin further discloses the printing device as recited in claim 13, wherein the printing device is an inkjet printer (printer, fig. 1, cols. 3-5) and the replaceable component is a toner cartridge (ink cartridge, fig. 3).

Regarding claim 38, Benjamin further discloses the method as recited in claim 1, wherein the software update comprises a software update for software (printer driver, fig. 4) installed on the printer.

Regarding claim 39, Benjamin further discloses the method as recited in claim 38, wherein the software update comprises an update for at least one of firmware (printer driver, fig. 4), an applet, color table and/or reference table for printer.

Regarding claim 40, Benjamin further discloses the method as recited in claim 39, wherein the firmware comprises at least one of processor-executable instructions (printer driver, fig. 4) or an embedded web server.

Regarding claim 41, Benjamin further discloses the method as recited in claim 1, wherein the software update comprises a software update for printer-related software (printer driver, fig. 4) installed on a host computer.

Regarding claim 42, Benjamin further discloses the method as recited in claim 41, wherein the software update comprises an update for at least one of a printer driver (printer driver, fig. 4), a printer status utility and/or a printer administrative utility.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3-5, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Benjamin et al as described in claim 1 above, and in view of Saldago et al (US 20020067504).

Regarding claim 3, Benjamin discloses a printer driver can be downloaded automatically without user's intervention and/or manually downloaded by users, but fails to teach and/or suggest wherein the validating further comprises determining if a verification indicator is set in memory of the printing device and validating that authority has been granted to download the software update if the verification indicator is set.

Salgado, in the same field of endeavor for download/upgrading new printer driver, teaches wherein the validating further comprises determining if a verification indicator is set in memory of the printing device and validating that authority has been granted to download the software update if the verification indicator is set (level of user interaction in the upgrade process can be adjusted to fit the preferences of the user, for example, automatically downloading and installing new driver without user interface or requires user's approval prior for downloading and installing new updates, abstract, pars. 9-11 and pars. 25-27).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made by modifying print system of Benjamin to include a method for setting a verification indicator in memory of the printing device and validating that authority has been granted to download the software update if the verification is set as taught by Salgado because of a following reason: (●) by pre-authorized validation of downloading new updates software

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automatically (i.e. downloading and installing new updates without user's intervention) saves times and costs, and to improve printer's performance.

Therefore, it would have been obvious to combine Benjamin with Salgado to obtain the invention as specified in claim 3.

Regarding claim 4, Benjamin further discloses the method as recited in claim 1, wherein the validating further comprises determining if a verification indicator is set in memory of a host computer (memory 12 and host processor 10, fig. 3, also, new printer driver can be downloaded automatically, col. 4, lines 5-20) connected to the printing device and validating that authority has been granted to download the software update if the verification indicator is set.

Regarding claim 5, Benjamin further discloses the method as recited in claim 1, wherein the validating further comprises accessing a remote site (accessing manufacture's website, col. 4, lines 1-20) and determining if a verification indicator is set at the remote site and validating that authority has been granted to download the software update if the verification indicator is set.

Regarding claim 17, Saldago further teaches the printing device is a laser printer (printer 14, fig. 3) and the replaceable component is a toner cartridge.

Response to Arguments

Applicant's arguments, see pages 13-23, filed 8/4/05, with respect to the rejection(s) of claim(s) 1 under 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of different interpretation of previous cited prior art of record.

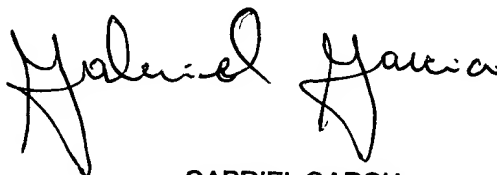
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thierry L. Pham whose telephone number is (571) 272-7439. The examiner can normally be reached on M-F (9:30 AM - 6:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (571)272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thierry L. Pham



GABRIEL GARCIA
PRIMARY EXAMINER